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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,942	07/17/2003	Andrew Tipler	03141-P0418B	1556
24126 7590 06/22/2007 ST. ONGE STEWARD JOHNSTON & REENS, LLC 986 BEDFORD STREET STAMFORD, CT 06905-5619			EXAMINER HYUN, PAUL SANG HWA	
			ART UNIT 1743	PAPER NUMBER
			MAIL DATE 06/22/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/621,942

Applicant(s)

TIPLER, ANDREW

Examiner

Paul S. Hyun

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2003.
- 2a) ☐ This action is **FINAL**: 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 15-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/19/03</u> . | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1743

### DETAILED ACTION

The preliminary amendment canceling claims 1-14, and introducing claims 15-25, filed on 7/17/03, has been acknowledged.

The preliminary amendment to enter continuing data into the Specification, filed on 7/17/03, has been acknowledged.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims **15, 16, 19, 22 and 23** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of Tipler (US 6,645,773 B2). Although the conflicting claims are not identical, they are not patentably distinct from each other.

Art Unit: 1743

Claim 1 of US 6,645,773 B2 recites a method for determining the temperature inside a sealed container comprising the steps of mixing a liquid solvent with a solid compound to create a saturated solution in a sealed container, allowing vapor of the solution to equilibrate in the headspace of the sealed container, taking chromatographic readings of the equilibrated vapor, and calculating the temperature based on the chromatographic readings.

Claims **17 and 20** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4 of Tipler (US 6,645,773 B2). Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 4 of US 6,645,773 B2 further recites that the solvent comprises n-dodecane and the solid comprises naphthalene.

Claims **18 and 21** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of Tipler (US 6,645,773 B2). Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 6 of US 6,645,773 B2 further recites that the solvent comprises n-octadecane and the solid comprises anthracene.

Claim **24** is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of Tipler (US 6,645,773 B2). Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 2 of US 6,645,773 B2 further recites that the chromatographic readings comprise readings of peak areas of the solvent and the solid compound.

Claim **25** is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of Tipler (US 6,645,773 B2). Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 3 of US 6,645,773 B2 further recites that the calculating step comprises the step of calculating the ratio of the readings of peak areas of the solvent and the compound.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims **15-21 and 23-25** are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for taking chromatographic readings of vapor inside a sealed container, does not reasonably provide enablement for taking chromatographic readings of vapor in a non-sealed container. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Art Unit: 1743

The claims must specify that the solution is enclosed within a sealed container. In order to enable a vapor of a solution to equilibrate and make an accurate chromatographic measurement of the vapor, the solution must be within a sealed container when the measurement is conducted. Otherwise, factors such as evaporation and uncertainty of the volume of the vapor will deleteriously affect the measurement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul S. Hyun whose telephone number is (571)-272-8559. The examiner can normally be reached on Monday-Friday 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PSH  
6/7/07

